

REMARKS

Applicants have carefully considered the July 30, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 4, 5 and 9 through 18 are pending in this application. In response to the Office Action dated July 30, 2004, claims 16 and 18 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Examiner requested evidence of priority that the international Application was co-pending with the U.S. National Application to obtain the benefit thereof pursuant to 35 U.S.C. § 120. As stated previously since an international preliminary examination had been requested within 19 months from the priority date, the term for entering the U.S. National Phase was extended to 30 months from the priority date. The time limit of April 29, 2001, which corresponds to 30 months from the priority date, fell on Sunday and, hence, the present U.S. National Application could be and was filed on April 30, 2001 (Monday). Thus, this Application was filed within the effective term (filed on April 30, 2001).

Moreover, in addition to Forms PCT/IB/332 and PCT/IPEA402, which were both previously submitted on February 19, 2004, Applicants make the following CERTIFICATION:

Applicants hereby certify that neither the international application nor the designation of the United States was withdrawn or considered to be withdrawn prior to the filing date of the present U.S. national (35 U.S.C. 111(a)) application.

Accordingly, for the reasons stated above, including the foregoing certification, Applicants respectfully submit that the present application is entitled to claim the benefit of the international application pursuant to 35 U.S.C. § 120. See M.P.E.P. § 1895.

Claim 18 was rejected under the first paragraph of 35 U.S.C. § 112. The Examiner asserted that there is no support for the use of the term “fuels” especially the use of hydrogen “fuels”. The Examiner acknowledged that the description did support the use of a fuel to create a flame. As such, Applicants have removed the term “fuels” and have replaced it with the term “fuel”. Applicants respectfully submit that the specification fully supports the claim limitation in such a way as to enable one skilled in the art to make and/or use the invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 4, 5, 9, 11, 16 and 17 were rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroo (JP 62-167235) in view of any one of Kortan et al. (U.S. Pat. No. 5,560,759, hereinafter “Kortan”), Oleskevich et al. (U.S. Pat. No. 5,790,735, hereinafter “Oleskevich”), and DiGiovanni (U.S. Pat. No. 5,966,491, hereinafter “DiGiovanni”). Applicants respectfully traverse the rejection under 35 U.S.C. §103.

The Examiner refers to the arguments previously advanced in the final Office action dated March 9, 2004 for the application of the Hiroo reference. The Examiner maintains the conclusion that one having ordinary skill in the art would have found it “... obvious to stretch and etch as much as desired/needed to get the results that one desires depending upon what

starting materials one has available, and what sizes are needed/desired during further processing - with no new or unexpected results” (ultimate paragraph on page 3 of the March 9, 2004 Office Action). Moreover, in the Advisory action dated June 18, 2004, the Examiner asserted that making something as big or as small as desired, is knowledge that is generally available to one of ordinary skill in the art. In the Office action dated July 30, 2004, the Examiner asserted that Kortan, Oleskevich and DiGiovanni each teaches that fibers with a ratio greater than 14 is conventional. Further, the Examiner relied on Onishi (U.S. Pat. No. 6,502,428), Onishi (6,076,376) and Roba (U.S. Pat. No. 6,371,394), (which were not cited in the statement of the rejection) to support the Examiner’s position that the dispersion characteristics depends upon how the fiber is drawn. Applicants respectfully traverse the rejection.

Applicants submit that Hiroo does not disclose or suggest a method of making a preform for a dispersion compensating fiber having a negative chromatic dispersion in a 1.55 μ m band and capable of compensating for a single mode fiber by increasing an absolute value of its chromatic dispersion, wherein the second collapsed body has an outer diameter of 14 times or more that of the core rod at the time when the second collapsing step ends. Applicants would stress that the preform of Hiroo is a material for obtaining a single-mode fiber or a dispersion-shifted fiber. In contradistinction to the preform formed by Hiroo, the preform formed in the claimed method is a material for obtaining a dispersion compensating fiber compensating for chromatic dispersion in a single-mode optical fiber.

Moreover, Kortan, at col. 6, lines 20-22, teaches that the core to clad ratios of about 0.005 to about 0.05 are preferred for single mode optical fiber. The area ratio of clad to core becomes 400 to 40000 when assuming that the core to clad ratio is a diameter ratio. Oleskevich, at col. 4, lines 38-45, teaches that the area ratio of cladding 12 (inner cladding) to core 10 is 12 to 400.

DiGiovanni, at col. 4, lines 58-64, teaches that the area ratio of cladding to core is 100-300. Applicants submit that the claimed invention is directed to a preform before a fiber drawing and defines a diameter ratio between members in the preform. However, each of Kortan, Oleskevich and DiGiovanni disclose a ratio of a resulted optical fiber after fiber drawing. Thus, the Examiner's reliance on the ratio of a resulted optical fiber in the applied references is improper since the claimed invention clearly is directed to the diameter ratio between members in the preform before any fiber drawing. Based upon the foregoing, Applicants submit that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

With respect to the Examiner's comments regarding both Ohnishi references and Roba, Applicants submit that the present specification teaches that the dispersion-compensating fiber of claim 16 has a negative chromatic dispersion in a 1.55 μm band and can compensate for a single mode fiber by increasing an absolute value of its chromatic dispersion. Claim 16 has been amended to describe, in part, a method of making a preform for a dispersion compensating fiber having a negative chromatic dispersion in a 1.55 μm band and capable of compensating for a single mode fiber by increasing an absolute value of its chromatic dispersion. Therefore, a person of ordinary skill in the art would have understood the kind of dispersion-compensating fiber recited in the claim.

Applicants, therefore, submit that the imposed rejection of claims 4, 5, 9, 11, 16 and 17 under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of one of Kortan,

Oleskevich and DiGiovanni, is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 10 and 15 were rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of any one of Kortan, Oleskevich or DiGiovanni, and further in view of Berkey (U.S. Pat. No. 5,894,537, hereinafter “Berkey”). Further, claims 12 through 14 were rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of any one of Kortan, Oleskevich, or DiGiovanni, and in further view of Kyoto (U.S. Pat. No. 5,221,309, hereinafter “Kyoto”). Applicants traverse.

These rejections under 35 U.S.C. § 103 of claims 10 and 15 and 12 through 14 are traversed. Specifically, claims 10 and 12 through 15 depend ultimately from independent claim 16. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 16 under 35 U.S.C. § 103. The additional references to Berkey and Kyoto do not cure the argued deficiencies of Hiroo and any one of the secondary references. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra*.

Applicants, therefore, submit that the imposed rejection of claims 10 and 15 under 35 U.S.C. §103, and the imposed rejection of claims 12 through 14 under 35 U.S.C. §103 are not factually or legally viable and, hence, solicit withdrawal thereof.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an

09/843,838

Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:idw
Facsimile: 202.756.8087
Date: January 27, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**